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AUS920010818US1
APPEAL BRIEF

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Michael W. Brown, *et al.*

Serial No.: 10/015,381

Filed: December 12, 2001

Title: Origin Device Based Caller
Identification

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Group Art Unit: 2645

Examiner: Elahee, MD S.

Atty Docket No.: AUS920010818US1

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Catherine Berglund
Catherine Berglund

APPEAL BRIEF

Honorable Commissioner:

This is an Appeal Brief filed pursuant to 37 CFR § 41.37 in response to the Final Office Action of July 6, 2005, and pursuant to the Notice of Appeal filed October 6, 2005.

REAL PARTY IN INTEREST

The real party in interest is the patent assignee, International Business Machines Corporation ("IBM"), a New York corporation having a place of business at Armonk, New York 10504.

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

STATUS OF CLAIMS

Claims 31-41 are pending in the case. All pending claims are on appeal.

STATUS OF AMENDMENTS

No amendments were submitted after final rejection. The claims as currently presented are included in the Appendix of Claims that accompanies this Appeal Brief.

SUMMARY OF CLAIMED SUBJECT MATTER

Applicants provide the following concise summary of the invention according to 37 CFR 1.192(c)(5). Methods, systems, and computer program products are provided for specifying telephone services for a particular caller. Embodiments include receiving, at an intermediary device, an authenticated caller identity for a call request from an origin device; retrieving a caller profile for said authenticated caller identity; and specifying a selection of services from among a plurality of services that are offered for said call request according to said caller profile described for example with reference to Figure 4, steps 1-6 at pages 31, line 5- page 33, line 5, page 14, lines 5 - 15; page 20, lines 21 - page 22, line 20; and page 25, line 1 - page 26, line 5.

All such references to the specification identify descriptions and discussions that are part of the detailed descriptions of exemplary embodiments of the present invention in the present application. Such descriptions and discussions are not limitations of the claims in the present application. The only limitations of the claims are set forth in the claims themselves.

GROUND OF REJECTION

Claims 31, 33, 35, 37, 39, and 40 stand rejected under 35 U.S.C § 102(e) as being anticipated by Bouvier, *et al.* (U.S. Patent No. 6,430,276). Claims 31, 35, and 39 stand rejected under 35 U.S.C § 102(e) as being anticipated by Gurfein, *et al.* (U.S. Patent Application Publication No. 2003/0081744). Claims 32 and 36 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Bouvier, *et al.* (U.S. Patent No. 6,430,276), in view of Moser *et al.*, (U.S. Patent No. 6,556,127). Claims 34, 38, and 41 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Bouvier, *et al.* (U.S. Patent No. 6,430,276), in view of Kawahara, *et al.*, (U.S. Patent Application Publication No. 2002/0184096).

ARGUMENT

Claims 31, 33, 35, 37, 39, and 40 stand rejected under 35 U.S.C § 102(e) as being anticipated by Bouvier *et al.* (U.S. Patent No. 6,430,276). Claims 31, 35, and 39 stand rejected under 35 U.S.C § 102(e) as being anticipated by Gurfein, *et al.* (U.S. Pub. No. 2003/0081744). Claims 32 and 36 stand rejected under 35 U.S.C § 103(a) as unpatentable over Bouvier *et al.* (U.S. Patent No. 6,430,276) in view of Moser *et al.* (U.S. Patent No. 6,556,127). Claims 34, 38, and 41 stand rejected under 35 U.S.C § 103(a) as unpatentable over Bouvier *et al.* (U.S. Patent No. 6,430,276) in view of Kawahara, *et al.* (U.S. Pub. No. 2002/0184096). Bouvier does not anticipate claims 31, 33, 35, 37, 39 and 40 as claimed in the present application. The combination of Bouvier and Moser and the combination of Bouvier and Kawahara cannot establish a prima facie case of obviousness. Claims 31-41 are therefore patententable and should be allowed. Applicants respectfully traverse each rejection individually below and request reconsideration of claims 31-41.

REJECTION UNDER 35 U.S.C § 102(e) OVER BOUVIER

Claims 31, 33, 35, 37, 39, and 40 stand rejected under 35 U.S.C § 102(e) as being anticipated by Bouvier (U.S. Patent No. 6,430,276). To anticipate claims 31, 33, 35, 37, 39, and 40 under 35 U.S.C. § 102(e), two basic requirements must be met. The first requirement of anticipation is that Bouvier must disclose each and every element as set forth in Applicants' claims. The second requirement of anticipation is that Bouvier must enable Applicants' claims. Bouvier does not meet either requirement and therefore does not anticipate Applicants' claims.

Bouvier Does Not Disclose Each and Every Element of
Claims 31, 33, 35, 37, 39, and 40

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Bouvier does not disclose each and every element of claim 31. Independent claim 31 claims "a method for specifying telephone services for a particular caller, comprising: receiving, at an intermediary device, an authenticated caller identity for a call request from an origin device; retrieving a caller profile for said authenticated caller identity; and specifying a selection of services from among a plurality of services that are offered for said call request according to said caller profile." Independent claim 31 claims specifying telephone services for a particular caller. In stark contrast, Bouvier discloses selecting a dialup access service provider for the caller. *See* Bouvier, abstract; column 6, lines 11-16; column 8, lines 15-57. Selecting a dialup access service is not specifying telephone services as claimed in independent claim 31.

The Office Action at page 4 states that Bouvier discloses receiving, at an intermediary device, an authenticated caller identity for a call request from an origin device at Figure 1, column 5, line 65 – column 6, line 13. Figure 1 is a generalized illustration of the

interaction of a public switched telephone network with different intranet/extranet/internet networks. Bouvier column 5, line 39-41. The generalized illustration of Figure 1 only illustrates that a public switched network, a public internet, a private intranet, and an extranet may coexist. Figure 1 does not disclose receiving, at an intermediary device, an authenticated caller identity for a call request from an origin device as claimed in the present invention. As such, the rejection should be withdrawn and the case should be allowed.

Column 5, line 65 – column 6, line 13 of Bouvier actually discloses:

The SCP 13 in the PSTN responds to a service request from the SSP 12 to from specific service logic programs on particular data according to the information contained in the service request, and to send back to the requesting SSP appropriate instruction. In the FIG. 2 arrangement, the SCP 13 is capable of identifying a particular customer. This can be achieved in different ways, for instance by means of a personal calling card which can be read by a card reader at the user telephone and verified by the PSTN. Alternatively the PSTN operators can provide a free phone number requiring the user to enter a PIN identification number before accessing the Internet and intranet network. Any other suitable means could also be used.

Once the SCP 13 in PSTN 1 has identified the particular customer, the method involves an access to database 50 to retrieve the customer profile corresponding to that person. That profile includes the list of access service providers to which this person has subscribed and their associated Access parameters.

Column 5, line 65 – column 6, line 13 is a general description of identifying a particular customer and retrieving a customer profile for the customer. Column 5, line 65 – column 6, line 13 does not disclose receiving, at an intermediary device, an authenticated caller

identity for a call request from an origin device as claimed in the present invention. In fact, the cited sections of Bouvier do not even address authenticated caller identities, call requests, or specifying telephone services for a particular caller at all. As such, Bouvier does not disclose each and every element of claim 31 and the rejection should be withdrawn.

The Office Action relies on column 6, lines 11-16 of Bouvier to disclose specifying a selection of services from among a plurality of services that are offered for said call request according to said caller profile as claimed in independent claim 31. Column 6, lines 11-16 actually disclose:

Alternatively the PSTN operators can provide a free phone number requiring the user to enter a PIN identification number before accessing the Internet and intranet network. Any other suitable means could also be used.

Once the SCP 13 in PSTN 1 has identified the particular customer, the method involves an access to database 50 to retrieve the customer profile corresponding to that person. That profile includes the list of access service providers to which this person has subscribed and their associated Access parameters.

Column 6, lines 11-16 is a general description of identifying a particular customer and retrieving a customer profile for the customer. Column 6, lines 11-16 does not disclose specifying a selection of services from among a plurality of services that are offered for said call request as claimed in claim 31. In fact, the cited sections of Bouvier do not even address services offered for a call request or specifying telephone services for a particular caller at all.

Furthermore, the rejection admits that Bouvier does not disclose specifying a selection of services from among a plurality of services that are offered for said call request as

claimed in claim 31, but instead relies on the theory of inherency to support the rejection. The Office Action dated July 6, 2005, states at page 4:

Bouvier further teaches specifying a selection of services from among a plurality of services that are offered for the call request according to the customer profile (col. 6, lines 11-16). (Note: each particular customer has subscribed a list of access service providers and each profile includes the list. Therefore, it is inherent that a selection of services from among a plurality of services are offered for a call request according to each particular customer profile.)

The rejection relies on the theory of inherency to argue that selecting an access service provider for a dialup network connection inherently selects telephone services. The rejection, however, is not accompanied by the required analysis to support a rejection relying on inherency. "In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) cited in MPEP § 2112. The rejection does not demonstrate why selecting an access service provider for a dialup network connection necessarily results in selecting telephone services. In fact, such inherency does not exist. Selecting an access service provider for a dialup network connection does not inherently select telephone services. Bouvier never mentions selecting telephone services and does not teach each and every element of independent claim 31. Claim 31 is patentable and should be allowed.

Claims 33-34 depend from independent claim 31 and include all of the elements of claim 31. Because Bouvier does not disclose each and every element of claim 31, Bouvier does not disclose each and every element of claim 33. As such, claims 33 and 34 are also patentable and should be allowed.

Independent claims 35 and 39 recite system and computer program product claims corresponding to independent claim 31 that include “means for” and “means, recorded on [a] recording medium,” for specifying telephone services for a particular caller. As discussed above, Bouvier discloses selecting an access service provider for dialup network connections not specifying telephone services for a particular caller. For the same reason that Bouvier does not disclose each and every element of claim 31, Bouvier does not disclose each and every element of claims 35 and 39. Independent claims 35 and 39 are patentable and should also be allowed.

Claims 36, 37, 38, 40, and 41 depend from independent claims 35 and 39 respectively and include all of the elements of the claims from which they depend. Because Bouvier does not teach each and every element of claims 35 and 39, Bouvier does not teach each and every element of claims 36, 37, 38, 40, and 41. As such, claims 36, 37, 38, 40, and 41 are also not anticipated by Bouvier.

Bouvier Does Not Enable
Applicants’ Claims 31, 33, 35, 37, 39, and 40

Not only must Bouvier disclose each and every element of claims 31, 33, 35, 37, 39, and 40 of the present invention within the meaning of *Verdegaal* in order to anticipate Applicants’ claims, but also Bouvier must be an enabling disclosure of Applicants’ claims 31, 33, 35, 37, 39, and 40 within the meaning of *In re Hoeksema*. In *Hoeksema*, the claims were rejected because an earlier patent disclosed a structural similarity to the applicant’s chemical compound. The court in *Hoeksema* stated: “We think it is sound law, consistent with the public policy underlying our patent law, that before any publication can amount to a statutory bar to the grant of a patent, its disclosure must be such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention.” *In re Hoeksema*, 399 F.2d 269, 273, 158 USPQ 596, 600 (CCPA 1968). The meaning of *Hoeksema* for the present case is that unless Bouvier places Applicants’ claims 31, 33, 35, 37, 39, and

40 in the possession of a person of ordinary skill in the art, Bouvier is legally insufficient to anticipate Applicants' claims 31, 33, 35, 37, 39, and 40 under 35 USC 102(e).

Bouvier does not enable claim 31. Independent claim 31 claims specifying telephone services for a particular caller. As discussed above, Bouvier discloses selecting a dialup access service provider for the caller. *See* Bouvier, abstract; column 6, lines 11-16; column 8, lines 15-57. Selecting a dialup access service is not specifying telephone services as claimed in independent claim 31. Bouvier therefore does not place one of ordinary skill in the art in possession of claim 31 and is therefore legally insufficient to anticipate claim 31.

Claims 33-34 depend from independent claim 31 and include all of the elements of claim 31. Because Bouvier does not place one of skill in the art in possession of claim 31, Bouvier does not place one of skill in the art in possession of claims 33 and 34. As such, claims 33 and 34 are also patentable and should be allowed.

Independent claims 35 and 39 recite system and computer program product claims corresponding to independent claim 31 that include "means for" and "means, recorded on [a] recording medium," for specifying telephone services for a particular caller. As discussed above, Bouvier discloses selecting an access service provider for dialup network connections not specifying telephone services for a particular caller. For the same reason that Bouvier does not place one of skill in the art in possession of claim 31, Bouvier does not place one of skill in the art in possession of claims 35 and 39. Independent claims 35 and 39 are patentable and should also be allowed.

Claims 36, 37, 38, 40, and 41 depend from independent claims 35 and 39 respectively and include all of the elements of the claims from which they depend. Because Bouvier does not place one of skill in the art in possession of claims 35 and 39, Bouvier does not place one of skill in the art in possession of claims 36, 37, 38, 40, and 41. As such, claims 36, 37, 38, 40, and 41 are also not anticipated by Bouvier.

REJECTION UNDER 35 U.S.C § 102(e) OVER GURFEIN

Gurfein Does Not Disclose Each and Every Element of
Applicants' Claims 31, 35, and 39

Claims 31, 35, and 39 stand rejected under 35 U.S.C § 102(e) as being anticipated by Gurfein, *et al.* (U.S. Pub. No. 2003/0081744). Gurfein does not disclose each and every element of claim 31. Independent claim 31 claims “a method for specifying telephone services for a particular caller, comprising: receiving, at an intermediary device, an authenticated caller identity for a call request from an origin device; retrieving a caller profile for said authenticated caller identity; and specifying a selection of services from among a plurality of services that are offered for said call request according to said caller profile.” Independent claim 31 claims specifying telephone services for a particular caller. In stark contrast, Gurfein discloses operating a telephone entertainment program. *See* Gurfein, abstract; paragraphs 0065-0071, column 6, lines 11-16; column 8, lines 15-57. Operating a telephone entertainment program is not specifying telephone services as claimed in independent claim 31. Gurfein therefore does not disclose each and every element of claim 31 and the rejection should be withdrawn.

The Office Action states that Gurfein discloses receiving, at an intermediary device, an authenticated caller identity for a call request from an origin device at Figure 1, and paragraph 0065. Figure 1 is a simplified flowchart illustration of a method for operating a telephone entertainment program. Gurfein, paragraph 0048. Figure 1 does not disclose receiving, at an intermediary device, an authenticated caller identity for a call request from an origin device. In fact, the simplified illustration of Figure 1 does not even address authenticated call requests, or specifying telephone services for a particular caller at all. As such, the rejection should be withdrawn.

Paragraph 0065 of Gurfein actually discloses:

[0065] Reference is now made to FIG. 1, which is a simplified flowchart illustration of a method for operating a telephone entertainment program, operative in accordance with a preferred embodiment of the present invention. In the method of FIG. 1 a caller accesses a telephone entertainment system using a voice communications network, such as the telephone network. A preferred implementation of a telephone entertainment system is described in greater detail hereinbelow with reference to FIGS. 6 and 7. The system then answers the call through a voice network interface. The caller's identity is then ascertained, such as by using Caller ID and/or having the caller enter a PIN number. The system then retrieves the caller's profile, where a profile has been previously established for the caller, and a list of audio entertainment programs, herein referred to as telephone shows, that would be appropriate for the caller based on the caller's profile. The system then presents the user with an audio message, typically including a personalized greeting, with a suggestion of possible shows that the caller may choose from. The user then responds, typically by voice, requesting one of the options.

Paragraph 0065 is a general description of a system that presents a user with suggestions of possible shows that the caller may choose from. Paragraph 0065 does not even address authenticated call requests, or specifying telephone services for a particular caller at all. As such, Gurfein does not disclose each and every element of claim 31 and the rejection should be withdrawn.

The Office Action relies on paragraphs 0065, 0066, and 0071 of Gurfein to disclose specifying a selection of services from among a plurality of services that are offered for said call request according to said caller profile according to said caller profile as claimed in independent claim 31. Paragraph 0065 Gurfein actually discloses:

[0065] Reference is now made to FIG. 1, which is a simplified flowchart illustration of a method for operating a telephone entertainment program,

operative in accordance with a preferred embodiment of the present invention. In the method of FIG. 1 a caller accesses a telephone entertainment system using a voice communications network, such as the telephone network. A preferred implementation of a telephone entertainment system is described in greater detail hereinbelow with reference to FIGS. 6 and 7. The system then answers the call through a voice network interface. The caller's identity is then ascertained, such as by using Caller ID and/or having the caller enter a PIN number. The system then retrieves the caller's profile, where a profile has been previously established for the caller, and a list of audio entertainment programs, herein referred to as telephone shows, that would be appropriate for the caller based on the caller's profile. The system then presents the user with an audio message, typically including a personalized greeting, with a suggestion of possible shows that the caller may choose from. The user then responds, typically by voice, requesting one of the options.

Paragraph 0065 is a general description of a system that presents a user with suggestions of possible shows that the caller may choose from. Paragraph 0065 does not disclose specifying a selection of services from among a plurality of services that are offered for said call request according to said caller profile as claimed in claim 31. Paragraph 0065 does not even address services offered for a call request or specifying telephone services for a particular caller at all. Gurfein does not disclose each and every element of claim 31 and the rejection should be withdrawn.

Paragraph 0066 of Gurfein actually discloses:

[0066] The system typically maintains pre-recorded audio segments, such as sound effects, music, audience responses, speech, etc., pre-defined speech recognition grammar definitions, and script segments, in addition to maintaining the caller's profile and history of system usage. When a

telephone show is selected, the system then composes the telephone show's audio content using the show's flow script, associated audio segments and grammars, and the user profile and history. A preferred implementation of a flow script is described in greater detail hereinbelow with reference to FIG. 2.

Paragraph 0066 is a general description of a system that composes a telephone show's audio content using the show's flow script, associated audio segments and grammars. Paragraph 0066 does not disclose specifying a selection of services from among a plurality of services that are offered for said call request according to said caller profile as claimed in claim 31. Paragraph 0066 does not even address services offered for a call request or specifying telephone services for a particular caller at all. Gurfein does not disclose each and every element of claim 31 and the rejection should be withdrawn.

Paragraph 0071 of Gurfein actually discloses:

[0071] One exemplary operational scenario of the method of FIG. 1 may be illustrated within the context of a humorous quiz show, in which characters, such as the characters of the television show The Simpsons.RTM., interact within a game show environment having comic elements. In this scenario the caller plays the role of a contestant interacting with any of six characters on the show. Four are the Simpson family members, a fifth is the announcer, and the sixth is the studio audience. Six "virtual performers" play these six roles in what is referred to herein as a "virtual theater." A preferred method of implementing a virtual theater is described in greater detail hereinbelow with reference to FIG. 5.

Paragraph 0071 is a general description of an operational scenario within the context of a humorous quiz show. Paragraph 0071 does not disclose specifying a selection of services from among a plurality of services that are offered for said call request according to said

caller profile as claimed in claim 31. Paragraph 0071 does not even address services offered for a call request or specifying telephone services for a particular caller at all. Gurfein does not disclose each and every element of claim 31 and the rejection should be withdrawn.

Furthermore, the rejection admits that Gurfein does not disclose specifying a selection of services from among a plurality of services that are offered for said call request according to said caller profile as claimed in claim 31, but instead relies on the theory of inherency to support the rejection. The Office Action dated July 6, 2005, states at page 5:

Gurfein further teaches specifying a selection of telephone shows (i.e. services) from among a plurality of telephone shows that are offered for the call request according to the caller profile (page 3, paragraphs 0065, 0066, 0071). (Note: each particular caller has subscribed a list of telephone shows and each profile includes the list. Therefore, it is inherent that a selection of telephone shows from among a plurality of telephone shows are offered for a call request according to each particular caller profile.)

The rejection relies on the theory of inherency to argue that the system that provides a suggestion of a telephone show and creates audio content of Gurfein inherently specifies a selection of services from among a plurality of services that are offered for said call request according to said caller profile. The rejection, however, is not accompanied by the required analysis to support a rejection relying on inherency. "In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) cited in MPEP § 2112. The rejection does not demonstrate why the system that provides a suggestion of a telephone show and creates audio content of Gurfein necessarily results in specifying a selection of services from among a plurality of services that are offered for said call request according to said caller

profile. In fact, such inherency does not exist. A telephone show is not a telephone service as claimed in independent claim 31. The system that provides a suggestion of a telephone show and creates audio content of Gurfein does not inherently select telephone services including specifying a selection of services from among a plurality of services that are offered for said call request according to said caller profile. In fact, Gurfein never mentions selecting telephone services because Gurfein discloses operating a telephone entertainment program. Gurfein does not teach each and every element of independent claim 31 and therefore cannot anticipate claim 31. Claim 31 is patentable and should be allowed.

Independent claims 35 and 39 recite system and computer program product claims corresponding to independent claim 31 that include “means for” and “means, recorded on [a] recording medium,” for specifying telephone services for a particular caller. As discussed above, Gurfein discloses operating a telephone entertainment program not specifying telephone services for a particular caller. For the same reason that Gurfein does not disclose each and every element of claim 31, Gurfein does not disclose each and every element of claims 35 and 39. Independent claims 35 and 39 are patentable and should also be allowed.

Gurfein Does Not Enable
Applicants’ Claims 31, 35, and 39

As discussed above, not only must Gurfein disclose each and every element of the claims of the present invention within the meaning of *Verdegaal* in order to anticipate Applicants’ claims, but also Gurfein must be an enabling disclosure of Applicants’ claims within the meaning of *In re Hoeksema*. Independent claim 31 claims specifying telephone services for a particular caller. In stark contrast, Gurfein discloses operating a telephone entertainment program. *See* Gurfein, abstract; paragraphs 0065-0071 column 6, lines 11-16; column 8, lines 15-57. Operating a telephone entertainment program is not specifying telephone services as claimed in independent claim 31 and does not inherently

result in specifying telephone services. Gurfein therefore does not place one of skill in the art in possession of independent claim 31.

Independent claims 35 and 39 recite system and computer program product claims corresponding to independent claim 31 that include “means for” and “means, recorded on [a] recording medium,” for specifying telephone services for a particular caller. As discussed above, Gurfein discloses operating a telephone entertainment program not specifying telephone services for a particular caller. For the same reason that Gurfein does not place one of skill in the art in possession of claim 31, Gurfein does not place one of skill in the art in possession of claims 35 and 39. Independent claims 35 and 39 are patentable and should also be allowed.

Claim Rejections – 35 U.S.C. § 103

Claims 32 and 36 stand rejected under 35 U.S.C § 103(a) as unpatentable over Bouvier (U.S. Patent No. 6,430,276) in view of Moser, *et al.* (U.S. Patent No. 6,556,127). Claims 34, 38, and 41 stand rejected under 35 U.S.C § 103(a) as unpatentable over Bouvier (U.S. Patent No. 6,430,276) in view of Kawahara, *et al.* (U.S. Pub. No. 2002/0184096). To establish a prima facie case of obviousness, three basic criteria must be met. *Manual of Patent Examining Procedure* §2142. The first element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a suggestion or motivation to combine Bouvier and Moser or Bouvier and Kawahara. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The second element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a reasonable expectation of success in the proposed combination of Bouvier and Moser or Bouvier and Kawahara. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The third element of a prima facie case of obviousness under 35 U.S.C. § 103 is that the proposed combination of Bouvier and Moser or Bouvier and Kawahara must teach or suggest all of Applicants’ claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). The combination of Bouvier and Moser or Bouvier and

Kawahara fail to meet the requirements of a prima facie case of obviousness. The rejection should be withdrawn and the case should be allowed.

Bouvier and Moser

The Combination Of Bouvier and Moser
Does Not Teach or Suggest all Of Applicants' Claim Limitation

To establish a prima facie case of obviousness, the proposed combination of Bouvier and Moser must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). Claim 32 depends from independent claim 31 and includes all of the limitations of claim 31. Claim 36 depends from independent claim 35 and includes all the limitations of claim 35. As discussed above, claims 31 and 35 claim a method and a system for specifying telephone services for a particular caller. In stark contrast, Bouvier discloses selecting a dialup access service provider for the caller. *See* Bouvier, abstract; column 6, lines 11-16; column 8, lines 15-57. Moser discloses speaker verification. *See* Moser, abstract, column 3, lines 57-67. Moser does not however disclose specifying telephone services for a particular caller including receiving, at an intermediary device, an authenticated caller identity for a call request from an origin device; retrieving a caller profile for said authenticated caller identity; and specifying a selection of services from among a plurality of services that are offered for said call request according to said caller profile. Because neither Bouvier nor Moser disclose each and every element of claims 32 and 36, the proposed modification cannot establish a prima facie case of obviousness. The rejection should be withdrawn and the claims should be allowed.

No Suggestion or Motivation to Combine Bouvier and Moser

To establish a prima facie case of obviousness, there must be a suggestion or motivation to combine Bouvier and Moser. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The suggestion or motivation to combine Bouvier and Moser must

come from the teaching of Bouvier or Moser, and the Examiner must explicitly point to the teaching within the reference suggesting the proposed modification. Absent such a showing, the Examiner has impermissibly used “hindsight” occasioned by Applicants’ own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.2d 488m 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989).

The Office Action at page 6 states as its sole rationale for motivation to combine Bouvier and Moser as:

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Bouvier to allow the authentication caller identity being authenticated by a voice utterance of the caller as taught by Moser. The motivation for the modification is to have doing so in order to provide the option of orally entering the subscriber identification.

The above reference in the Office Action does not point to any specific teaching in either Bouvier or Moser suggesting such a modification or combination. Instead, the Office Action merely makes a naked assertion that there is a motivation for combining the references. Such an assertion, without more, is incomplete and improper. As such, the proposed combination cannot establish a prima facie case of obviousness and the rejection should be withdrawn.

No Reasonable Expectation of Success in the
Proposed Combination of Bouvier and Moser

To establish a prima facie case of obviousness, there must be a reasonable expectation of success in the proposed modification of Bouvier. *In re Merck & Co., Inc.*, 800 F.2d

1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). Claims 32 and 36 claim a method and system for specifying telephone services for a particular caller. In stark contrast, Bouvier discloses selecting a dialup access service provider for the caller. *See* Bouvier, abstract; column 6, lines 11-16; column 8, lines 15-57. Moser discloses speaker verification. *See* Moser, abstract, column 3, lines 57-67. Neither Bouvier nor Moser disclose specifying telephone services for a particular caller as claimed in claim 32 and 36. The combination of Bouvier and Moser cannot together work to achieve what neither reference discloses alone. Therefore, there is no reasonable expectation of success in the combination of Bouvier and Moser. Bouvier and Moser cannot establish a prima facie case of obviousness and the rejection of claims 32 and 36 should be withdrawn.

Bouvier and Kawahara

Combination of Bouvier and Kawahara Does Not Teach or Suggest

All of Applicants' Claim Limitations

The combination of Bouvier and Kawahara does not teach or suggest all of Applicants' claim limitations. Rejected claims 34, 38, and 41 claim a method, system and computer program product for specifying telephone services for a particular caller. As discussed above, Bouvier discloses selecting a dialup access service provider for the caller. *See* Bouvier, abstract; column 6, lines 11-16; column 8, lines 15-57. Bouvier does not disclose specifying telephone services for a particular caller. Kawahara is an unrelated disclosure of a portable terminal device aimed at immediately providing a consumer with advertising information about goods that the consumer finds on another person. Kawahara, paragraph 0002, paragraph 0014. Kawahara has nothing to do with specifying telephone services for a particular caller. The combination of Bouvier and Kawahara therefore does not disclose each and every element of claims 34, 38 and 41 and therefore cannot establish a prima facie case of obviousness. The rejection should be withdrawn.

No Suggestion or Motivation to Combine Bouvier and Kawahara

There is no suggestion or motivation to combine Bouvier and Kawahara. The suggestion or motivation to combine Bouvier and Kawahara must come from the teaching of the references themselves and the Examiner must explicitly point to the teaching Bouvier and Kawahara suggesting the proposed combination. Absent such a showing, the Examiner has impermissibly used “hindsight” occasioned by Applicants’ own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.2d 488m 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989).

The Office Action at page 6 states as its sole rationale for motivation to combine Bouvier and Moser as:

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Bouvier to allow the retrieving the caller provide from the systems management server as taught by Kawahara. The motivation for the modification is to have doing so in order to provide various services as desired by the caller.

The above reference in the Office Action does not point to any specific teaching in either Bouvier or Kawahara suggesting such a modification or combination. Instead, the Office Action merely makes a naked assertion that there is a motivation for combining the references. Such an assertion, without more, is incomplete and improper. As such, the proposed combination cannot establish a prima facie case of obviousness and the rejection should be withdrawn.

No Reasonable Expectation of Success in the Proposed Combination
Of Bouvier and Kawahara

There is also no reasonable expectation of success in the proposed combination of Bouvier and Kawahara. As discussed above, Bouvier discloses selecting a dialup access service provider for the caller. *See* Bouvier, abstract; column 6, lines 11-16; column 8, lines 15-57. Bouvier does not disclose specifying telephone services for a particular caller. Kawahara is an unrelated disclosure of a portable terminal device aimed at immediately providing a consumer with advertising information about goods that the consumer finds on another person. Kawahara, paragraph 0002, paragraph 0014. Combining the selecting of a dialup access service provider for the caller as disclosed in Bouvier with the portable terminal device for advertising of Kawahara will not work to specify telephone services as claimed in claims 34, 38, and 41. The proposed combination of Bouvier and Kawahara therefore cannot support a prima facie case of obviousness and the rejection should be withdrawn.

The Four Factual Inquires Required By The Supreme Court For An Obviousness
Rejection Have Not Been Properly Considered, Determined, And Applied

Establishing a prima facie case of obviousness for claims 32, 34, 36, 38, and 41, which has not been accomplished, is not the end of obviousness analysis, it is the beginning. The rejection of these claims under 35 U.S.C. 103 are deficient because the proper factual inquiries have not been considered, determined, and applied as required by the Supreme Court in *Graham v. John Deere*. The rejection should therefore be withdrawn and the case allowed.

The Manual of Patent Examining Procedure §2141 explicitly states:

Patent examiners carry the responsibility of making sure that the standard of patentability enunciated by the Supreme Court and by the Congress is

applied in each and every case. The Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966), stated:

Under Section 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy. . .

This is not to say, however, that there will not be difficulties in applying the nonobviousness test. What is obvious is not a question upon which there is likely to be uniformity of thought in every given factual context. The difficulties, however, are comparable to those encountered daily by the courts in such frames of reference as negligence and scienter, and should be amenable to a case-by-case development. We believe that strict observance of the requirements laid down here will result in that uniformity and definitiveness which Congress called for in the 1952 Act.

Office policy has consistently been to follow *Graham v. John Deere Co.* in the consideration and determination of obviousness under 35 U.S.C. 103.

As quoted above, the four factual inquiries enunciated therein as a background for determining obviousness are briefly as follows:

- (A) Determining of the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the pertinent art; and
- (D) Evaluating evidence of secondary considerations.

Manual of Patent Examining Procedure §2141.

In over three years of prosecution and after issuing five office actions, the Examiner has yet to even mention the four factual inquiries required by the Supreme Court in *Graham v. John Deere*, and none of the four factual inquiries has been properly considered, determined, and applied in any of the office actions in this case.

The first factual inquiry that has not been properly considered and determined is ascertaining the differences between the prior art and the claims in issue. More particularly, in each office action, the Examiner has only identified elements in Applicants' claims not found in one reference and then attempted to find a similar element in another reference to support an obviousness rejection. Such analysis is improper and incomplete. "Ascertaining the differences between the prior art and the claims at issue requires interpreting the claim language, and considering both the invention and the prior art references as a whole." MPEP §2141.02. Furthermore, "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." *Id.*, citing *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530 (Fed. Cir. 1983). The Office Actions of

April 24, 2003, October 8, 2003, March 10, 2004, October 20, 2004, July 6, 2005, are deficient because the Examiner has only identified differences between Applicants' claims and the various references including Bouvier, Moser, and Kawahara. This analysis is improper and incomplete because Examiner has not determined whether Applicants' claims as a whole would have been obvious in view of any of the proposed combinations of the references as required by the Manual of Patent Examining Procedure. In fact, the Examiner has not even mentioned how any claim as a whole would be obvious in rejecting any claim. As such, the obviousness rejections should be withdrawn and the case should be allowed.

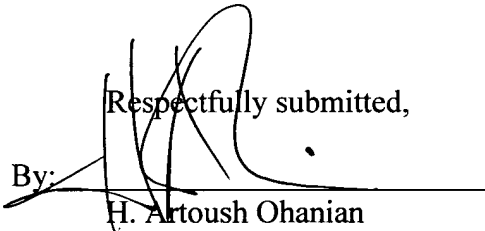
The second factual inquiry that has not been properly considered, determined, and applied is resolving the level of ordinary skill in the pertinent art. "The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry." MPEP §2141.03 citing *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718, 21 USPQ2d 1053, 1057 (Fed. Cir. 1991). "The examiner must ascertain what would have been obvious to one of ordinary skill in the art at the time the invention was made, and not to the inventor, a judge, a layman, those skilled in remote arts, or to geniuses in the art at hand." *Id.* citing *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 218 USPQ 865 (Fed. Cir. 1983), cert. denied, 464 U.S. 1043 (1984). "Factors that may be considered in determining level of ordinary skill in the art include (1) the educational level of the inventor; (2) type of problems encountered in the art; (3) prior art solutions to those problems; (4) rapidity with which innovations are made; (5) sophistication of the technology; and (6) educational level of active workers in the field." *Id.* citing *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 696, 218 USPQ 865, 868 (Fed. Cir. 1983), cert. denied, 464 U.S. 1043 (1984). The Office Actions of April 24, 2003, October 8, 2003, March 10, 2004, October 20, 2004, and July 6, 2005, fail to apply a single factor to consider in determining the level of ordinary skill in the art. In fact, in over three years of prosecution and five office actions, no analysis at all considering the level of one of ordinary skill in the art for the instant case has been performed. The rejection is therefore deficient and the case should be allowed.

Claims 31, 33, 35, 37, 39, and 40 stand under 35 U.S.C § 102(e) as being anticipated by Bouvier and Gurfein. Bouvier and Gurfein do not disclose each and every element of Applicants' claims and do not enable Applicants' claims. Bouvier and Gurfein therefore do not anticipate Applicants' claims. Claims 32, 34, 36, 38, and 41 stand rejected under 35 U.S.C § 103(a) as unpatentable over Bouvier in view of Moser and Bouvier in view of Kawahara. The combination of Bouvier and Moser and Bouvier and Kawahara fail to meet the requirements of a prima facie case of obviousness. Applicants respectfully request reconsideration of claims 31-41.

In view of the forgoing arguments, reversal on all grounds of rejection is requested.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Date: December 6, 2005

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APPENDIX OF CLAIMS
ON APPEAL IN PATENT APPLICATION OF
MICHAEL WAYNE BROWN, SERIAL NO. 10/015,381

CLAIMS

What is claimed is:

31. A method for specifying telephone services for a particular caller, comprising:

receiving, at an intermediary device, an authenticated caller identity for a call request from an origin device;

retrieving a caller profile for said authenticated caller identity; and

specifying a selection of services from among a plurality of services that are offered for said call request according to said caller profile.
32. The method for specifying telephone services for a particular caller according to claim 31, wherein said authenticated caller identity is authenticated by a voice utterance of said caller.
33. The method for specifying telephone services for a particular caller according to claim 31, wherein retrieving a caller profile further comprises:

retrieving said caller profile from a profile database within said intermediary device.

34. The method for specifying telephone services for a particular caller according to claim 31, wherein retrieving a caller profile further comprises:
- retrieving said caller profile from a systems management server.
35. A system for specifying telephone services for a particular caller, comprising:
- an intermediary device communicatively connected to a telephone network;
- means for receiving, at said intermediary device, an authenticated caller identity for a call request from an origin device;
- means for retrieving a caller profile for said authenticated caller identity; and
- means for specifying a selection of services from among a plurality of services that are offered for said call request according to said caller profile.
36. The system for specifying telephone services for a particular caller according to claim 35, wherein said authenticated caller identity is authenticated by a voice utterance of said caller.
37. The system for specifying telephone services for a particular caller according to claim 35, wherein retrieving a caller profile further comprises:
- means for retrieving said caller profile from a profile database within said intermediary device.
38. The system for specifying telephone services for a particular caller according to claim 35, wherein retrieving a caller profile further comprises:
- means for retrieving said caller profile from a systems management server.

39. A computer program product for specifying telephone services for a particular caller, comprising:
- a recording medium;
- means, recorded on said recording medium, for receiving an authenticated caller identity for a call request from an origin device;
- means, recorded on said recording medium, for retrieving a caller profile for said authenticated caller identity; and
- means, recorded on said recording medium, for specifying a selection of services from among a plurality of services that are offered for said call request according to said caller profile.
40. The computer program product for specifying telephone services for a particular caller according to claim 39, further comprising:
- means, recorded on said recording medium, for retrieving said caller profile from a profile database within said intermediary device.
41. The computer program product for specifying telephone services for a particular caller according to claim 39, further comprising:
- means, recorded on said recording medium, for retrieving said caller profile from a systems management server.